

## **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested.

### **I. Status of the Application**

Claims 204 - 253 are pending, with claims 1 - 203 having been previously canceled. Applicant cancels claims 249 - 253 without prejudice or disclaimer, and amends claims 204 - 210, 214 - 217, 222, 223, 226- 229, 239, 241, 242, 244 and 245 to provide improved clarity and consistency among related claims. No new matter is introduced. Support for the amendments may be found, for example, with reference to Applicant's specification at page 2, line 29 - page 3, line 1, page 4, line 34 - page 5, line 33, page 7, line 18 - page 8, line 8, and to Applicant's FIGs. 2 and 3(a) - 3(f).

### **II. Examiner Interview**

Applicant thanks the Examiner for granting a telephone interview on April 18, 2007 to discuss the final Office Action of February 7, 2007. The Examiner's comments were quite helpful in the preparation of this Response.

### **III. Claim Rejections under 35 U.S.C. §§ 102, 103**

Claims 204 - 209, 215 - 221, 224 - 229, 231 - 236, and 239 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2002/0002474 to Michelson et al. Claims 210 - 214, 222, 223, 237, 238 and 245 - 253 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelson in view of "drkoop.com & Quintiles Launches Service to Recruit Clinical Trial Patients on the Internet," PR Newswire, June 28, 1999 ("Newswire"). Claims 230 and 240 - 244 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelson in view of

U.S. Patent No. 6,171,112 to Clark ("Clark"). As claims 249 - 253 have been canceled without prejudice or disclaimer, Applicant submits that the rejection as claims 249 - 253 is moot. Applicant amends claims 204 - 210, 214 - 217, 222, 226- 229, 239, 241, 242, 244 and 245 to further clarify the nature of his invention, and respectfully traverses the rejections of claims 204 - 248 under 35 U.S.C. §§ 102, 103. In particular, Applicant submits that the Michelson and Newswire references must be disqualified as prior art references in the rejections under 35 U.S.C. §§ 102, 103 for the reasons stated below.

The rejections of each of claims 204 - 248 are based on the Examiner's application of Michelson either as an anticipatory reference under 35 U.S.C. § 102(e), or as a reference which in combination with one of Newswire or Clark under 35 U.S.C. § 103(a) is asserted by the Examiner as making the claimed subject matter obvious. Michelson discloses an on-line forum for the exchange of clinical trial information among trial study sponsors, study investigators and potential study subjects (see, e.g., abstract of Michelson).

As the application filing date of April 21, 2000 for the present application predates Michelson's application filing date of August 8, 2001, Michelson qualifies as a prior art reference only by claiming priority under 35 U.S.C. § 120 from International Application No. PCT/US1/02936, which was filed on January 29, 2001, and further under 35 U.S.C. § 119(e) to Provisional Patent Application No. 60/178,634 ("the '634 Application"), which was filed on January 28, 2000.

As indicated above, the Newswire reference was published on June 28, 1999.

On August 19, 2004, Applicants mailed a Response to Non-Final Office Action which disqualified the Newswire reference by demonstrating by Declarations of the inventor and others familiar with the invention that the date of invention preceded the publication date of the Newswire reference (June 28, 1999). Enclosed with this Response are copies of the Response of August 19, 2004 and copies of the Declarations of James D. Marks (Exhibit 1), Bonnie Goldman (Exhibit 2), Dahlia Elsayed (Exhibit 3), and James K. Dewey (Exhibit 4) which were enclosed with the

Response of August 19, 2004. Associated Exhibits A - D, which provide copies of certain documents described in Exhibits 1 - 4, are not enclosed but can be provided upon the Examiner's request.

The Response of August 19 in part made the following argument:

Generally, unless it is a statutory bar, a rejection based on a publication may be overcome by proving that the invention of the claimed subject matter by applicant occurred prior to the date of the cited publication. See M.P.E.P. 715.01. In instances, such as here, where applicant invented the claimed subject matter prior to the date of the cited publication, the rejection may be overcome by filing a specific affidavit or declaration under 37 C.F.R. 1.131 establishing the date of invention for the subject claims as prior to the date of the cited publication. M.P.E.P. 715.01(d). A declaration is permitted instead of an affidavit. 37 C.F.R. 1.68.

Accordingly, applicant respectfully directs the Examiner's attention to the following declarations: the Declaration of James D. Marks, applicant of the claimed subject matter (Exhibit 1, hereinafter "the J. Marks Dec."); the Declaration of Bonnie Goldman (Exhibit 2; hereinafter "the B. Goldman Dec."); the Declaration of Dahlia Elsayed (Exhibit 3, hereinafter "the D. Elsayed Dec."); and, the Declaration of Jason K. Dewey (Exhibit 4, hereinafter "the J. Dewey Dec."). Also attached as Exhibit 5 are Exhibits A, B, C and D which contain evidence relevant to each of the declarations in Exhibits 1, 2, 3 and 4. The Declarations establish that applicant completed the invention as described and claimed in the subject patent application, including each element of each independent claim. In addition, the completion of the invention for each independent claims occurred in the United States prior to the publication of the June 28, 1999 drkoop.com press release [the "Newswire" reference]. More particularly, the Declarations establish the teachings of each element of each independent claim based on work completed prior to June 28, 1999...

...it is clear that applicant James D. Marks completed the invention claimed in each of the independent claims prior to the June 28, 1999 publication of drkoops.com press release. This completed work is an actual reduction to practice of the claimed invention since it was available to the public and executed by multiple members of the public, including at least three members of the public by May 25, 1999, and the database generated by the implementation of the invention was accessed, printed out and/or stored for at least three members of the public as early as May 25, 1999 or as late as May 27, 1999. Therefore, a showing of diligence is not required. As a result, the June 28, 1999 publication

of the drkoop.com press release is not available as a reference against the subject claims.

Applicant submits that the Declarations submitted on August 19, 2004 also establish that Applicant completed the invention as presently claimed (in at least independent claims 204, 210, 215, 226, 239 and 245) prior to the publication of the Newswire reference. As the Newswire reference predates the '634 Application, Applicant further submits that the Declarations of August 19, 2004 establish that Applicant successfully completed the invention as presently claimed before the earliest effective date available for the Michelson reference.

With reference to current independent claims 204, 210, 215, 226, 239 and 245, Applicant asserts that the Declarations establish that the invention as completed prior to June 28, 1999 reflected at least the following claim elements:

- A method for on-line recruitment of individuals wishing to volunteer for consideration as potential candidates for participating as research subjects in a plurality of clinical trials (see, e.g., page 13 of the Response of August 19).
- A server of a recruitment service provider for transmitting a health survey to an end-user terminal for gathering an individual's contact information and at least one of the individual's personal or medical information (see, e.g., pages 13 and 14 of the Response of August 19).
- The server storing the health survey information securely in a database (see, e.g., pages 14 and 15 of the Response of August 19).
- Comparing stored survey information to clinical trial selection criteria to identify potential candidates, and providing information to clinical trial researchers about potential candidates (see, e.g., page 17 of the Response of August 19).
- The server transmitting a participation agreement to the end-user terminal, and requiring assent to the participation agreement as a requirement for accepting and storing the health survey information (see, e.g., page 13 of the Response of August 19).

